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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,821	01/25/2002	Takayoshi Togino	P 284148 OL85300N-US-DIV	4939

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EXAMINER

SHAHER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/054,821

Applicant(s)

TOGINO, TAKAYOSHI

Examiner

Ricky D. Shafer

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-12 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-12, 14-18 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/501,320.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application):
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2872

1. Applicant's election of Group I in Paper No. 6 and species "A", depicted by Fig. 5 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 19-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention and/or species. Election was made **without** traverse in Paper No. 6 and 8.
3. Claims 6-12, 14-18 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 6 and 7, line 3, claims 8 and 9, lines 2-3, and claim 25, lines 28 and 32, the use of the language "a light beam" lacks proper nexus with respect to claim 25, line 8. The examiner suggest changing the above mentioned language to read --the light beam--.

In claims 10, lines 2-3 and claims 11 and 12, line 3, the use of the language "said prism member" is vague, indefinite and/or confusing. It is unclear to the examiner whether the above mentioned language is referring to the first prism member or the second prism member.

In claim 14, lines 2 and 4, the use of the language "optical surfaces of said prism member" is vague, indefinite and/or confusing. It is unclear to the examiner what optical surfaces applicant is referring too. Moreover, it is unclear to the examiner whether applicant is referring to the first prism member or the second prism member. Thus the metes and bounds of the claim is unclear.

Art Unit: 2872

In claims 15-18, line 2, the use of the symbols "X-" and "Y-" is vague, indefinite and/or confusing. It is unclear to the examiner whether the above symbols are referring to a negative direction or something else completely different.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6-12, 14-18 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nanba et al ('196).

To the extent the claims are definite, Nanba et al discloses an image-forming optical system comprising a first prism member (B1) having a first entrance surface (R1), a first reflecting surface (R2), a second reflecting surface (R3) and a first prism exit surface (R4), a second prism member (B2) having a second prism entrance surface (R6), a third reflecting surface (R7), a fourth reflecting surface (R8) and a first exit surface (R9) and an intermediate image plane (R5) arranged in an optical path between the second reflecting surface and the third reflecting surface, note Figures 13-15 along with the associated description thereof, wherein said image forming optical system of Nanba et al possesses a power ratio within the range specified by applicant in claims 15 to 18.

Art Unit: 2872

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-12, 14-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Araki et al ('844) in view of Nanba et al ('196).

To the extent the claims are definite, Araki et al discloses an image-forming optical system comprising a first prism member having a first entrance surface (R2), a first reflecting surface (R3), a second reflecting surface (R4) and a first prism exit surface (R5), a second prism member having a second prism entrance surface (R5), a third reflecting surface (R6), a fourth reflecting surface (R7) and a first exit surface (R8) and an intermediate image plane arranged in an optical path between the second reflecting surface and the third reflecting surface, wherein said image forming optical system of Araki et al possesses a power ratio within the range specified by applicant in claims 15 to 18, note Fig. 1 along with the associated description thereof, except for the prism members being separate.

Nanba et al teaches it is known to use an image-forming optical system having separate prism members in the same field of endeavor for the purpose of selectively, varying the relative positions of the prism members.

Art Unit: 2872

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the prisms members of Araki et al to be separable as taught by Nanba et al in order to provide for independent adjustability, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Note *Nerwin v. Erlichman*, 168 USPQ 177, 179.

8. The Examiner objects to applicant's claim for priority under 35 U.S.C. 119(a)-(d), the inventorship under 37 CFR 1.48 and the oath or declaration under 37 CFR 1.63.

The present application (10/054,821) declares Mr. Takayoshi Togino as the sole inventor of the subject matter being claimed and claims foreign priority to a Japanese document 11-034314 filed on 12/02/99.

However, patent abstracts of Japan (see attachment) clearly identifies Kenno Kokichi as the sole inventor of Japanese document 11-034314 filed on 12/02/99. Accordingly, it is unclear to the examiner who is the actual inventor of the present application.

9. Any inquiry concerning this communication should be directed to R. D. Shafer at telephone number (703) 308-4813.

RDS

July 9, 2003

  
RICKY D. SHAFER  
PATENT EXAMINER  
ART UNIT 2872